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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte VIJAY E. SWAMIDASS

Appeal 2010-002079
Application 11/030,247
Technology Center 2100

Before LANCE LEONARD BARRY, HOWARD B. BLANKENSHIP, and
ST. JOHN COURTENAY III, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant seeks our review under 35 U.S.C. § 134(a) of the Examiner's final decision rejecting claims 1-18. We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We Affirm-in-part.

INVENTION

Appellant's invention relates generally to dynamic documentation. More specifically, the invention on appeal relates to a system that can be used to generate process documents and provide maintenance to process documents. (*See Spec. para. [0026]*).

Claim 1 is illustrative:

1. A dynamic documentation system, comprising:

a generating logic configured to generate a process document that describes a sequence of steps for performing a selected process where the process document is configured using:

a skeleton document that includes a plurality of steps for performing the selected process, where the plurality of steps include references to task documents; and

a plurality of task documents that are maintained separately from the skeleton document, where a task document includes instruction for performing a specific task that can be associated to a selected step; and

a viewing logic configured to dynamically generate the process document in response to a request to view the process document by building the skeleton document with the task documents referenced within the skeleton document.

Rejections

1. Claims 3 and 9-13 stand rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter.
2. Claims 1-3 and 5-18 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Black (U.S. Patent No. 6,763,500 B2 (filed Dec. 1,

2000)).

3. Claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Black and Salisbury (U.S. Patent No. 6,397,231B1 (filed Aug. 31, 1998)).

§101 Rejection

ISSUE

Did the Examiner err in concluding that claims 3 and 9-13 are directed to non-statutory subject matter? (*See* Ans. 3).

ANALYSIS

Appellant contends that according to MPEP § 2106.01, dependent claim 3 and independent claim 9 are statutory. (App. Br. 11-12).

We disagree. We refer Appellant to the February 23, 2010 “*Subject Matter Eligibility of Computer Readable Media*” policy statement by PTO Director David J. Kappos, as published in the Official Gazette of the United States Patent and Trademark Office (USPTO) (reproduced in part below):

The [USPTO] is obliged to give claims their broadest reasonable interpretation consistent with the specification during proceedings before the USPTO. *See In re Zletz*, 893 F.2d 319(Fed. Cir. 1989) (during patent examination the pending claims must be interpreted as broadly as their terms reasonably allow). The broadest reasonable interpretation of a claim drawn to a computer readable medium (also called machine readable medium and other such variations) typically covers forms of non-transitory tangible media and transitory propagating signals per se in view of the ordinary and customary meaning of computer readable media, particularly when the specification is silent. *See* MPEP 2111.01. When the

broadest reasonable interpretation of a claim covers a signal per se, the claim must be rejected under 35 U.S.C. § 101 as covering non-statutory subject matter. *See In re Nuijten*, 500 F.3d 1346, 1356-57 (Fed. Cir. 2007) (transitory embodiments are not directed to statutory subject matter) and Interim Examination Instructions for Evaluating Subject Matter Eligibility Under 35 U.S.C. § 101, Aug. 24, 2009; p. 2.

1351 Off. Gaz. Pat. Office 212 (Feb. 23, 2010) (Italics added), *available at* <http://www.uspto.gov/web/offices/com/sol/og/2010/week08/TOC.htm#ref20>

This reasoning is applicable here. We observe that Appellant's Specification broadly describes a computer-readable medium as covering both statutory and non-statutory embodiments:

[0017] "Computer-readable medium", as used herein, refers to a medium that participates in directly or indirectly providing *signals*, instructions and/or data. A computer-readable medium may take forms, including, but not limited to, non-volatile media, volatile media, and *transmission media*. Non-volatile media may include, for example, optical or magnetic disks and so on. Volatile media may include, for example, optical or magnetic disks, dynamic memory and the like. Transmission media may include coaxial cables, copper wire, fiber optic cables, and the like. *Transmission media can also take the form of electromagnetic radiation, like that generated during radio-wave and infra-red data communications, or take the form of one or more groups of signals. Common forms of a computer-readable medium include, but are not limited to,* a floppy disk, a flexible disk, a hard disk, a magnetic tape, other magnetic medium, a CD-ROM, other optical medium, punch cards, paper tape, other physical medium with patterns of holes, a RAM, a ROM, an EPROM, a FLASH-EPROM, or other memory chip or card, a memory stick, *a carrier wave/pulse*, and other media from which a computer, a processor or other electronic device can

read. Signals used to propagate signals, instructions, data, or other software over a network, like the Internet, can be considered a “computer-readable medium.”

(Spec. 3-4, ¶[0017])(italics and underline added for emphasis).

“The four categories [of § 101] together describe the exclusive reach of patentable subject matter. If a claim covers material not found in any of the four statutory categories, that claim falls outside the plainly expressed scope of § 101 even if the subject matter is otherwise new and useful.” *In re Nuijten*, 500 F.3d 1346, 1354 (Fed. Cir. 2007). Thus, we conclude the scope of claims 3 and 9-13 covers non-statutory subject matter under § 101.

In the Reply Brief, Appellant attempts to expressly disclaim non-statutory embodiments of the claimed computer readable medium:¹

Must the applicant expressly disclaim non-statutory subject matter whenever the term “computer-readable medium” is used? If so, applicant hereby acknowledges that the present claims are intended to cover only statutory subject matter.”

(Reply Br. 3, ¶2).

While prosecution disclaimer is a preliminary consideration in determining literal infringement, *Southwall Techs., Inc. v. Cardinal IG Co.*, 54 F.3d 1570, 1578 (Fed. Cir. 1995), the USPTO does not review patent infringement issues. Patent infringement is a federal question that falls under the subject matter jurisdiction of the federal court system. *See* 28

¹ A prosecution disclaimer narrows the ordinary meaning of claim terms by excluding specific claim term interpretations disclaimed during prosecution. *Omega Eng’g, Inc. v. Raytek Corp.*, 334 F.3d 1314, 1323 (Fed. Cir. 2003). In contrast, prosecution history estoppel comes into play after no literal infringement is found. *SouthwallTechs, Inc. v. Cardinal IG Co.*, 54 F.3d 1570, 1578 (Fed. Cir. 1995).

U.S.C, § 1331. The federal courts apply a different standard of claim construction² than the USPTO, and may consider a prosecution disclaimer as being a limit on literal patent claim protection through claim construction. *See Biodex Corp. v. Loredan Biomedical, Inc.*, 946 F.2d 850, 862-63 (Fed. Cir. 1991) (comparing prosecution disclaimer and prosecution history estoppel).

In contrast, during prosecution before the USPTO, Appellant's claims are given their broadest reasonable interpretation consistent with the specification, and the claim language is read in light of the specification as it would have been interpreted by one of ordinary skill in the art. *In re Amer. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004) (citations omitted). Therefore, Appellant's prosecution disclaimer statement (Reply Br. 3) has no bearing on our claim construction, because the USPTO applies a different standard of claim construction than the federal courts.³

For the aforementioned reasons, we conclude that a broad but reasonable construction of the claimed computer-readable medium covers

² *See Markman v. Westview Instruments, Inc.* 52 F.3d 967, 979 (Fed. Cir. 1995), *aff'd*, 517 U.S. 370 (1996) (“To ascertain the meaning of claims, we consider three sources: The claims, the specification, and the prosecution history’ . . . ‘Expert testimony, including evidence of how those skilled in the art would interpret the claims, may also be used.’”)(internal quotations and citations omitted).

³ *But cf.* “Where the specification makes clear that the invention does not include a particular feature, that feature is deemed to be outside the reach of the claims of the patent, even though the language of the claims, read without reference to the specification, might be considered broad enough to encompass the feature in question.” *Scimed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc.*, 242 F.3d 1337, 1341 (Fed. Cir. 2001).

both statutory (non-transitory tangible media) and non-statutory embodiments of computer readable mediums (transitory propagating signals).

Therefore, we sustain the Examiner's rejection of claims 3 and 9-13 under § 101 because the broadest reasonable interpretation of the claimed computer-readable medium covers non-statutory transitory propagating signals per se.

Rejection under § 102

ISSUE

Based upon our review of the administrative record, we have determined that the following issue is dispositive in this appeal regarding the rejection under §102:

Did the Examiner err in finding that Black discloses “*a skeleton document that includes a plurality of steps for performing the selected process, where the plurality of steps include references to task documents,*” within the meaning of independent claim 1? (claim 1)(emphasis added) (*See App. Br. 13-14*).

ANALYSIS

Appellant contends, *inter alia*, that the aforementioned limitations are not disclosed by Black. (App. Br. 13-14). The Examiner broadly reads the claimed “skeleton document” on Black’s “main file 108,” and the claimed “task documents” on Black’s “auxiliary files 110.” (Ans. 4; *see also* Black, col. 1, l. 64; col. 2, ll. 65-66, Fig. 1).

At the outset, we find unpersuasive the Examiner's response that there is no indication whether these references have to be directly in the file, or that they can be *indirect* references. (Ans. 14). Claim 1 requires that the skeleton document *includes* a plurality of steps that include references to *task documents*. Thus, in order to anticipate claim 1, Black must at least disclose that the main file 108 (skeleton document) includes references to the auxiliary documents 110 (task documents). Based upon our review of the evidence, we are in accord with the Appellant's contention that the main file 108 includes a reference to the *merging logic 106* and *schema 112*, and *not* necessarily to the auxiliary files, either directly or indirectly. (App. Br. 14-15; *see also* Black, Figs. 1 and 3). We note that the aforementioned limitations argued by Appellant (re: claim 1) are recited in commensurate form in independent claims 9 and 14.

Regarding the "means for" claim language of independent 18, we find the weight of the evidence supports the Appellant's position as articulated in the principal Brief:

Independent claim 18 recites a system that comprises means for configuring an instructional document by defining a skeleton document having a plurality of step identifiers where the step identifiers include references to instruction contents. Black fails to teach this element since information about the auxiliary files (e.g. the number and location of auxiliary files) are maintained in a database 114 (Black, column 3, lines 60-62). Black teaches that the merging logic 108 determines this information from the database 114, not from references in the main file (Black, column 3, lines 51-65). Therefore, Black fails to teach a means for configuring a skeleton document that includes references to instruction contents. The main file of Black is not configured with the recited references and thus Black does not have and does not need a component that configures a skeleton document in this manner. Therefore,

Black fails to teach each and every element of claim 18 and fails to support a prima facie anticipation rejection. The rejection should be reversed.

Claim 18 further recites “means for retrieving the references to instruction contents from the skeleton document.” Since Black fails to teach a skeleton document that includes references to instruction contents, it then follows that Black fails to teach a component that retrieves the references from the skeleton document.”

(App. Br. 19).

Therefore, for essentially the same reasons argued by Appellant, we reverse the Examiner’s anticipation rejection of each independent claim on appeal. (Claims 1, 9, 14, and 18). Because we have reversed the Examiner’s rejection of each independent claim on appeal, we also reverse the Examiner’s anticipation rejection over Black for dependent claims 2, 3, 5-8, 10-13, and 15-17.

Rejection of claim 4 under §103

As noted above, dependent claim 4 is rejected under §103 as being unpatentable over Black and Salisbury. We do not find, nor has the Examiner established, that Salisbury cures the deficiencies of Black that are discussed *supra*. Accordingly, we reverse the §103 rejection of claim 4 for the same reasons discussed *supra*.

DECISION

We affirm the Examiner’s §101 rejection of claims 3 and 9-13.

We reverse the Examiner’s § 102 rejection of claims 1-3 and 5-18.

We reverse the Examiner’s §103 rejection of claim 4.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 41.50(f).

ORDER
AFFIRMED-IN-PART

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